TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2150718
BY ORANGE PERSONAL COMMUNICATIONS SERVICES LTD
TO REGISTER A TRADE MARK IN CLASSES 18 & 25

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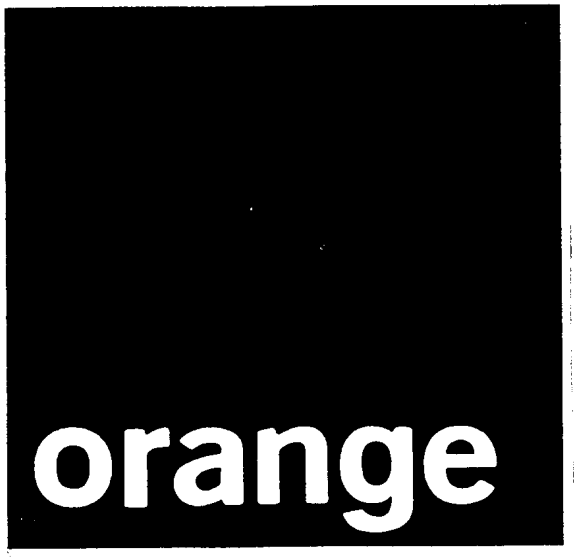
DECISION AND GROUNDS OF DECISION

On 12 November 1997, Orange Personal Communications Services Ltd of St James Court, Great Park Road, Almondsbury Park, Bradley, Stoke, Bristol, applied under the Trade Marks Act 1994 for registration of the following mark:



The representation, as filed, is shown in the colours orange and white, but the application is not limited to colour.

The goods claimed are as follows:

Class 18 Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; bags; cases; wallets; purses; card holders; umbrellas, parasols and walking sticks.

Class 25 Clothing; footwear, headgear; all included in Class 25.

Objection was taken against the mark under Section 3(1)(b) on the grounds that the mark consists essentially of the word "orange" contained within a non-distinctive square background

device, the whole being devoid of distinctive character for e.g. goods coloured orange. Objection was also taken under Section 5(2) of the Act in respect of Class 25 only, because of the existence of registration number 1531626 in Class 25 for the word only mark "ORANGE GAL". This registration is subject to separate disclaimers of the words "ORANGE" and "GAL".

Hearing and Decision

At a hearing at which the applicants were represented by Mrs H Buckley of RGC Jenkins & Co, the objections were maintained, and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 (as amended) to state in writing the grounds of my decision and the materials used in arriving at it. The relevant parts of Section 3(1)(b) of the Act is set out below:

> "The following shall not be registered -
>
> (b) Trade marks which are devoid of any distinctive character
>
> provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it".

The Prima Facie Case for Registration

At the hearing, Mrs Buckley put forward arguments in support of acceptance of the mark as a totality. The case for registration, also argued after the hearing in correspondence, may be summarised as follows:

- the mark, as a whole, performs the function of a trade mark. It consists of a three part mark i.e. the word "orange", a coloured square and the unusual placement of the word "orange" within the square.

- Mrs Buckley offered to exclude any goods coloured orange if this was felt to assist the case for acceptance.

- the applicant has now become the proprietor of the only citation raised against this application, namely 1531626 "ORANGE GAL" in Class 25. Assignment of this mark on 31 August 1999 transferred all of the goodwill associated with this mark to the applicant company. As this mark constituted a citation when in its previous ownership, this means that the current application should be able to derive some prior rights in the registration, and also in other registrations in Classes 18 and 25 in the applicants name, namely "THE DIFFERENCE IS ORANGE" and "MR ORANGE".

- the applicant has made a significant commitment and investment in the use of the

main corporate trade mark (the mark applied for) and this application will therefore be seen simply as another registration in these classes in the ORANGE family of marks.

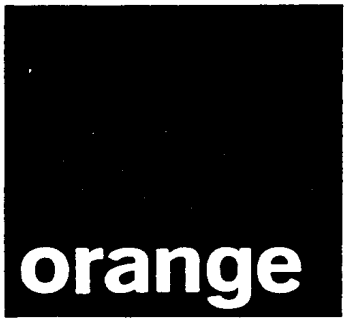
At the hearing, I said that any colour, presented as a word or as a representation of a single colour, borders on the unregistrable for these general consumer items where colour can be such an important part of the purchasing process. However, I conceded that this mark is presented in a particular way which would enable the mark to proceed should the proviso to Section 3 be satisfied. I clarified at the hearing that, in my opinion, the public would not see this mark as a badge of trade origin unless they had learned that this is so with the benefit of use on these, or similar goods, in the UK market. I allowed a period of three months from the date of the hearing to enable Mrs Buckley to consider the filing of evidence for my consideration.

The citation under Section 5(2) of the Act, number 1531626, was maintained at the hearing and Mrs Buckley explained that they were actively seeking consent from the owners of this cited mark. I allowed further time to enable this to be done. Some time later, on 31 August 1999, this trade mark was actually assigned to the applicant's company and therefore ceased to be an official objection against this application proceeding.

Acquired Distinctiveness: the Applicant's Evidence

Since the hearing, the applicants have argued for acceptance of the mark based on the following evidence.

The applicant relies upon evidence filed previously in application number 2108402A for the word only mark ORANGE, also application number 2108404A for the following device and word mark:



Both of these applications, in classes 18 and 25, have now been refused. The evidence consists of Statutory Declarations and exhibits of Clifford Sydney Cooper and a Statutory Declaration of Michael Dines.

Mr Cooper is the Managing Director of Orange Music and Electrical Company Limited (formerly known as Orange Musical Industries Limited). The primary commercial interests of the company since 1968 being the manufacture and retail of electronic and other musical instruments under the stylised word "ORANGE" as presented below:

Mr Cooper goes on to give details for the following clothing and related goods sold under the stylised word "ORANGE" as follows.

Product	**Date of First Sale**
Tee shirts	1969
Singlets	1970
Bomber jackets	1970
Leather belts	1970
Caps and wooly hats	1970
Badges	1970
Bags for musical instruments	1970
Holdall bags	1970

Samples of some of these clothing items are given in the exhibits. There are no exhibits to cover the Class 18 items. Sales in the UK of these items were approximately £2-3,000 per year in the early 1970s rising to £10,000 per year since the mid 1990s. Sales of carrier bags, holdalls and bags adapted to carry musical instruments averaged out at around £20,000 per year since the 1970s. Sales have all been limited to within and around the music industry. Mr

Cooper states that a large number of goods bearing the trade mark have also been given away for promotional purposes through dealers in the UK and at music Trade Fairs. He goes on to state that by an agreement effective from 24 December 1997, all goodwill and reputation in the stylised word "ORANGE" was assigned to this applicant company. I note that this was after the date of this application.

Mr Dines is an employee of Orange Musical and Electrical Company Limited (formerly known as Orange Musical Industries Limited) managing the manufacturing side of the company's business. He states that he also has had an on-going involvement in the retail side of the business.

Mr Dines states that the primary product range of the company consists of musical instruments and associated equipment used in connection with the performance and recording of music. The company has also made sales of other products including clothing, holdalls and belts. These have been sold and distributed in the UK since 1969 in the case of tee-shirts and carry bags and since 1970 for other items, although they ceased producing carry bags around 1990.

Mr Dines states that the goods concerned were originally sold and distributed through the company's dealer network in the music industry and at music Trade Fairs, although around 1995 the company set up a retail outlet called Gigwear Shop in London and since then the products have been sold and distributed from these premises. He says that the company has a dealer network of around 100 dealers spread throughout the UK and that the items continue to be referred to as e.g. "Orange tee shirts" and "Orange caps" and so on. However, as I have already noted, the applicant could not claim the benefit of this goodwill at the relevant date.

Draft evidence of use of the actual mark applied for in this application was filed, but never formalised. This consists of a draft Statutory Declaration of Jennifer Primrose Wilson, International General Counsel for the Orange group of companies. Ms Wilson states that the applicant's core business is in the telecommunications field encompassing all goods and services associated therewith. The applicant company launched its services under the trade mark ORANGE and also the ORANGE device, the subject of this application, on 28 April 1994, and Ms Wilson gives a list of all registrations at that date at Annex A (although it should be noted that some cases are pending).

Ms Wilson states that in March 1996, the applicant launched its "Orange Extras" catalogue featuring a whole range of items sold under the "Orange" device mark including goods covered by this application. This catalogue is aimed at distributors, dealers and retailers who purchase items from the catalogues for their use in promoting the applicant's telecommunications goods and services or for sale to the public within their stores. By the time a press release was issued on 2 August 1996, this catalogue was available to over 4,000 dealers, distributors and high street retailers through the UK for them to purchase items. The Class 18 and 25 items from the "Orange Extras" catalogue are also available to subscribers to the applicant's mobile telecommunications network through the applicant's O Magazine which is distributed to subscribers three times a year. Also, these goods are readily and widely available to the general public through the applicant's Orange shops.

Sales under the mark applied for leading up to the date of application (and beyond) are given

as follows:

Year	Total Unit Sales of Class 18 & 25 Goods	Total Sales Value
1 April 1996- 31 March 1997	14,437	£92,373
1 April 1997 - 31 March 1998	12,612	£78,489

Acquired Distinctiveness: Decision on the Evidence

When considering evidence of user it is important to bear in mind not only the facts in relation to the market(s) but also the strength of the Section 3 objection. Here we have a composite mark consisting of the word "orange" in a square box. The word is placed towards the bottom of the box which is coloured orange, although there is no limitation as to colour. The identity of this mark is therefore carried by the word "orange" and the presentation is only apparent from a visual inspection of the mark.

Objection to the word "ORANGE" is strong in my view bearing in mind general consumer items such as these where colour can be an important part of the purchasing process. No one would see "orange" shirts as a trade mark for shirts even if it is, in fact, a mis-description. Consequently, Mrs Buckley's offer to exclude orange coloured items was not felt to assist. Unless colour can be considered fanciful in relation to the goods concerned, it seems to me that the evidence must be sufficiently convincing to justify acceptance. The presentation of the word "orange" within the square box does not provide sufficient surplus in the mark to imbrue the mark with the distinctive character required under Section 3(1)(b) of the Act.

The evidence filed on application numbers 2108402A and 2108404A does not prove the case for acceptance. This evidence refers to a different mark (i.e. the stylised word ORANGE) and the sales figures and market saturation are extremely limited bearing in mind the huge market in the UK for such general consumer items. Sales have been restricted to within music circles and sales from a retail outlet are restricted to the Gigwear Shop only, in London. Further, the applicant did not own the goodwill at the relevant date.

The draft evidence filed in respect of this application is not sufficient to warrant acceptance, even if it was formalised. The proviso to Section 3 makes clear that the Registrar must only take into account any evidence of use prior to the date of filing. In this case the length of user is therefore only around 18 months. The Statutory Declaration of Ms Wilson goes on to cover evidence filed after the date of application which is far more substantial but which I may not take into account. I therefore take the view that this mark would not have been recognised by a significant proportion of the general public as a badge of trade origin at the time the application was made.

In British Sugar PLC v James Robertson & Sons Limited (1996) RPC 281, Jacob J. made the following comments regarding the evidence of use submitted in support of the mark TREAT:

"I think the Registrar was wrong to accept this evidence as demonstrating that the mark was "capable of distinguishing" for the purpose of the Act. Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - it taken by the public as a badge of trade origin."

"I am, or course, aware that the words "Toffee Treat" are written in a fancy way. But then so are many other mere descriptors. One only has to look at how British Sugar write such words as "meringue mix" or "golden syrup" to see parallel sorts of use. I do not think this affects the matter one way or the other".

In AD 2000 trade mark (1997) RPC 168, Mr Geoffrey Hobbs QC said:

"Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat* Trade Mark [1990] RPC 511 at 517 in the following terms:

"That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd's* Trade Mark Application (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence" ".

Finally, I do not accept the Agent's argument that the application may proceed on prior rights with earlier registrations because these are for different marks altogether. The word "ORANGE" forms only a part of these marks in each case, and the proviso to Section 3 makes clear that a trade mark which is excluded from prima facie registration by Section 3(1)(b) to (d) may nevertheless be registered if:

"Before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

It appears to me therefore that the words "acquired a distinctive character as a result of the use made of it" should, in principle, be regarded as meaning the use made of the mark put forward for registration. There is no provision in the 1994 Act for acceptance because of "special circumstances".

In a similar vein, I am not persuaded to accept the application because of the agent's argument that the applicant company has built up a family of marks under the corporate brand logo (i.e. the mark applied for) for similar types of products. I bear in mind the comments of Mr Matthew Clark QC in the unreported decision of the GIBSON appeal (application number 2129557 dated 17 December 1999) where he said:

> "While I think that Counsel for the applicants did accept that the question as to whether the proviso to Section 3 of the 1994 Act applies must turn on evidence of use, it appeared to me that at times his submissions were amounting almost to a legal proposition that, in certain situations, a non-distinctive mark may acquire a distinctiveness in relation to one class of goods, simply because it had acquired a distinctiveness in a relation to very different types of goods emanating from the same source. If that was a correct understanding of the applicant's position then, in my view, it clearly goes too far, if it is meant to be a proposition of general application, which means that, in certain classes of cases, the necessary evidential basis for distinctiveness having been acquired can be foregone."

He went on in that decision to comment:

> "..... I consider that it is not sufficient, in a case such as the present, to say that, absent adequate evidence, an inference of distinctiveness can be drawn simply because of the distinctiveness of the mark or a similar mark when used in relation to the proprietors other goods."

Conclusion

The mark is not acceptable in the prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

The evidence filed to substantiate the claim that the mark has acquired a distinctive character is not sufficient to satisfy the proviso to Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application, and for the reasons given above, it is refused under the terms of Section 37(4) of the Act.

Dated this 21 day of June 2000

Janet Folwell
For the Registrar
The Comptroller General

(NB the annexe is only available as a paper copy)